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PATENT APPLICATION IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Customer No.: 23641

Application No.: 09/810304

Confirmation

No.: 9103

Filing Date: March 16, 2001

Group Art

Unit: 3629

Examiner

Name: Jonathan P. Ouellette

Attorney

Docket No.: 26893/82373

First Named

Inventor: DeTore, Arthur W.

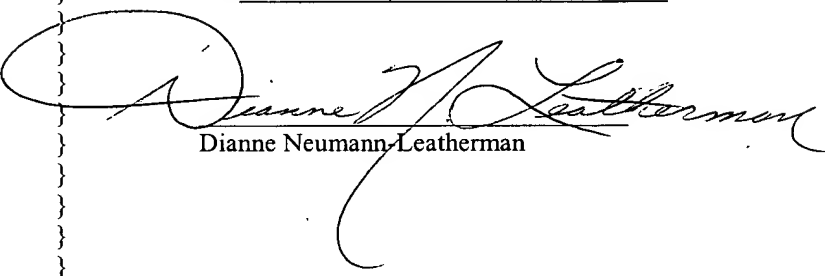
Title:

METHOD FOR
STRUCTURING
UNSTRUCTURED DOMAINS
TO CREATE VALUE

Certificate Under 37 CFR 1.8(a)

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Brief, Commissioner for Patents,
P. O. Box 1450, Alexandria, VA 22313-
1450

on November 6, 2006


Dianne Neumann-Leatherman

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- (a) Return receipt postcard
- (b) Reply Brief Under 37 CFR 41.41
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Remarks:


 Bobby B. Gillenwater
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Date: November 6, 2006



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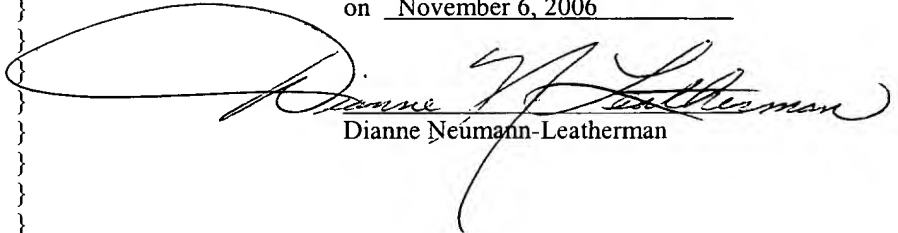
**BEFORE THE BOARD OF PATENT
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REPLY BRIEF UNDER 37 CFR §41.41

Mail Stop Appeal Brief-Patents
Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a reply to the Examiner's Answer mailed September 5, 2006. No new issues are raised in this reply. No new or non-admitted amendments, or new or non-admitted affidavits or other evidence are included in this reply.

REPLY

In numbered paragraph 3, under Section “(9) Grounds of Rejection” of the Answer, the Examiner restates the rejection of independent Claim 19, as originally set forth in numbered paragraph 5 of the final rejection from which appeal is taken. However, in restating the rejection in the Answer, the Examiner does, for the first time, refer more specifically to portions of the Asplen disclosure in support. Appellant and the undersigned respectfully submit that such specific citations should have been provided in the initial and/or Final Office Actions. Basing rejections upon broad conclusory statements is improper. Providing, or attempting to provide, support for such rejections for the first time in an Examiner’s Answer should not be condoned, absent justifications which are here lacking.

Notwithstanding the conclusory nature of the rejections appealed from, Appellants and the undersigned attempted to respond fully to Asplen in the Appeal Brief, and expressly stand by all the arguments set forth in the brief.

Appellants and the undersigned respectfully submit that the Examiner’s attempt to support the previous rejections by specific citations to Asplen must fail. For example, a limitation of independent Claim 19 reads:

“developing an estimate of costs associated with developing a **knowledge map** cataloging and describing at least some of said elements of information associated with the domain, and developing an estimate of the value of said **knowledge map**;”

The Examiner cites column 3, lines 49-67 through column 4, lines 1-13 of Asplen as disclosing this limitation. This portion of Asplen’s disclosure begins as follows:

In general, opportunity assessment chapter 2.0 is for determining if there is a reasonable opportunity for success *with the product*. This chapter establishes the feasibility of the *product* from a technological, market and strategic perspective. In this chapter ...

The financial analysis referred to near the end of this citation clearly relates to a *product* that may or may be launched in the market place. This is to be expected, given that Asplen discloses a computer-based “product planning system.” The subject claim limitation, on the other hand, requires developing an estimate of costs associated with developing a **knowledge map** cataloging and describing at least some of the *elements of information* associated with the

domain, and developing an estimate of the value of the **knowledge map**. The claimed step, in the context of the method of independent Claim 19, requires development of an estimate of costs associated with an increased ordering (in the form of a knowledge map) of elements of information associated with the subject domain. Moreover, the subject step further requires developing an estimate of the value of the increased level of order.

In this late attempt at justifying the original rejection, the Examiner is equating the product referred to by Asplen with the knowledge map of the subject claim limitations. Appellants respectfully submit that such an interpretation of Asplen is strained, and indicates the Examiner's continued refusal to interpret the claims on appeal in the context of, and in view of, the specification and related drawings of Appellants' application. The incremental ordering of elements of information in an unstructured domain by, for example, developing a knowledge map if the costs of such development and the value added justify such development, is not the same thing as the "opportunity assessment" portion of Asplen's product planning system.

With reference to the last three steps of Claim 19, the Examiner cites broadly to columns 4 and 5 of Asplen, apparently meaning to equate the "business plan chapter 3.0" of Asplen's system to the steps of:

comparing the estimates of costs and value and, based on said comparison, performing at least one of the steps of:

storing and maintaining said model and said plurality of elements of information; and

developing and storing the knowledge map so as to add structure and impart value to said domain.

The cited section of Asplen describes "business plan chapter 3.0" of Asplen's system. In connection with this section, Asplen states "this chapter uses research, testing, trailing, developing and sourcing to determine the feasibility for the product." Appellants and the undersigned respectfully submit that reliance upon this portion of Asplen as disclosing the subject limitations of independent Claim 19, when those limitations are considered in context and in light of the specification and its explicitly-defined terms, makes no sense whatsoever. Indeed, this portion of the Examiner's rejection remains fatally flawed due to its conclusory nature. If, in fact, Asplen discloses the above-quoted steps, the Examiner should be able to identify some specific disclosure in the two columns broadly referenced. It is respectfully

requested that the Board of Appeals step back and consider as a whole what is claimed in independent Claim 19 under appeal, and reject the Examiner's attempt to read that claim upon broad and disparate portions of the Asplen disclosure.

With regard to dependent Claim 20, the Examiner has supplemented the original conclusory rejection with a citation to column 3, lines 10-27 of Asplen. This portion of Asplen describes the evaluation of a new idea according to predetermined criteria. The idea is assigned a score from 1-10 for each of certain criterion identified by the organization. The Examiner is equating this portion of Asplen's system with the further definition of the step of "developing an initial domain model" of Appellant's claimed method. This is the same portion of the disclosure relied on by the Examiner in connection with the "developing an initial domain model" step of independent Claim 19.

Appellants and the undersigned respectfully submit that the step of developing an initial domain model, when considered in context and in light of Appellants' specification, is not the same as the qualitative evaluation (i.e., "scoring") of a new idea, as described in the cited portion of Asplen. The fact that the Examiner did not cite this portion of Asplen in the original and Final Office Actions suggests to the undersigned that the citation in the Examiner's Answer is either an afterthought, or an attempt to "fit" Asplen's disclosure to the claimed method. Appellants and the undersigned respectfully submit that the Examiner has continually refused to view the claimed method as a whole, and consider it in the context of the accompanying specification, including the defined terms set forth in the Evidence Appendix of the Appeal Brief.

With regard to the remaining dependent claims, the Examiner has supplemented the original conclusory rejections set forth in the Final Office Action by citations and references to portions of Asplen. However, in all of the citations, the Examiner continues to equate the "product," which is the subject of Asplen's product planning system, to the elements of information, the knowledge map, the knowledge clearing house, or other claimed element without regard to the differences which exist between these elements, and between each of them and the "product" referred to by Asplen. Refuting each and every one of these citations would be needlessly repetitive (since the citations themselves are certainly repetitive). If Appellants are

to rely upon repetition, they would prefer to repeat the paragraph which begins near the bottom of page 10 of the Appeal Brief which reads as follows:

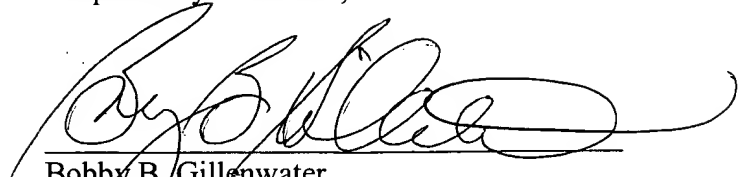
Appellants respectfully submit that, when viewed in a light most favorable to the Examiner, Asplen arguably shows a “domain” that has been structured to accomplish a specific result (i.e., product planning). However, the particular method by which such structure was imparted to such “domain” is neither disclosed nor suggested. This fact illustrates a significant difference between the disclosure of Asplen and the subject matter of Appellants’ application and claims. Namely, Asplen’s disclosure relates to a system which is designed to gather information to be used for the specific purpose of product planning. Appellants’ method, on the other hand, is not a data-gathering tool. It is a specific method for imparting structure to identified bodies of information, by degrees and only to the extent increased levels of structure are justified by the creation or addition of value in excess of the costs of the added structure.

Appellants and the undersigned respectfully submit that the basic difference between the claimed subject matter and the Asplen disclosure is captured in this portion of the Appeal Brief. If this basic difference is accepted, the inappropriateness of the Examiner’s reliance upon Asplen is readily apparent.

CONCLUSION

For all the reasons set forth above, and in the Appeal Brief, Appellants respectfully submit that Claims 19-32 on appeal are patentable over Asplen. Appellants respectfully submit that the Examiner’s rejections of Claims 19-32 are in error and respectfully request that these rejections be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bobby B. Gillenwater", written over a horizontal line.

Bobby B. Gillenwater

Reg. No. 31,105

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